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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,910	10/29/2003	Brian H. Silver	07-2116-A	9259
20306 7590 03/14/2008 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER WEAVER, SUE A				
ART UNIT		PAPER NUMBER		
3781				
MAIL DATE		DELIVERY MODE		
03/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,910

Applicant(s)

SILVER, BRIAN H.

Examiner

Sue A. Weaver

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-20, 22-34, 36-39, 42-56, 58-69 and 71 is/are pending in the application.
- 4a) Of the above claim(s) 17, 18, 36, 37, 58, 59 and 61-69 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13, 19, 20, 22-29, 32, 38, 39, 42-45, 47-52, 54 and 60 is/are allowed.
- 6) ☒ Claim(s) 14, 15, 30, 46, 53, 55, 56 and 71 is/are rejected.
- 7) ☒ Claim(s) 31, 33 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Applicant's election without traverse of Group I1/30/06 and the specie of nipple 410 in the reply filed on 1/30/06 and 6/22/06 is acknowledged.

Claims 17, 18, 36, 37, 58, 59 and 61-69 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/30/06 and 6/22/06.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 14,15, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishimaru et al, JP '076, of record taken alone or in combination of Dreyfus '152 also of record.

4. In view of applicant's broad definition of "substantially solid" on page 9 of the specification, the nipple of Ishimaru et al with the duct in figure 18 which is longer than it is wide may be considered to be substantially solid. Given the hardness taught the nipple of Ishimaru et al is considered to be capable of contraction in as much as applicant's claimed structure is.

Note that Dreyfus teaches a nipple with a solid portion with at least one channel and an integral mounting portion. To have formed the nipple of a soft material to provide more natural nursing would have been obvious in view of Ishimaru et al.

5. Claims 30 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 14 and 15 above, and further in view of Yamamoto et al; JP '498, of record.

To have formed the mounting portion of a different hardness or shore A of 40-60 for a better seal would have been obvious in view of such teaching by Yamamoto et al.

6. Claim 71 remains rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 14 and above, and further in view of Parkin '236, of record.

To have added a venting structure to the attachment portion would have been obvious in view of such teaching by Parkin.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 30 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 30 recites the limitation "said one or more ducts" in line 4. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 46 recites the limitation "said elongated nipple" in line 2. There is insufficient antecedent basis for this limitation in the claim.

11. Claims 31, 33 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 1-13, 19, 20, 22-29, 32, 38, 39, 40-45, 47-52, 54 and 60 are allowed.
13. Applicant's arguments, see page 11 pf the amendment, filed 11/29/07, with respect to the rejection of claims 34 and 39 have been fully considered and are persuasive. The rejection of the claims has been withdrawn.

However applicant argument regarding what is considered to be a solid nipple portion is curious given applicants definition at page 9 of the specification. Contrary to applicant's arguments Dreyfus does teach a duct in a solid portion in a nipple to simulate natural nursing. Ishimaru et al merely recognizes a range of hardness which accomplishes a similar result. To have used such a hardness to make the nipple softer would have been most obvious in view of the teaching by Ishimaru et al.

14. Claims 16, 21, 35, 40, 41, 57, 70 and 72 have been canceled.
15. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Art Unit: 3781

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning
facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Weaver whose telephone number is (571) 272-4548. The examiner can normally be reached on Tuesday-Friday from 5:30 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor is Anthony Stashick. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sue A. Weaver/

Primary Examiner, Art Unit 3781